

### **REMARKS**

Without prejudice and in the interests of facilitating prosecution applicant has canceled claims 1-18 which were withdrawn from consideration by the Examiner as being drawn to non-elected inventions. Five new claims were added. As a result claims 19-28 are now pending in the application. Claims 19, 20 and 22 are currently amended. Claims 21 and 23 are original. Claims 24-28 are new. A copy of the claims now pending in the application showing changes made to currently amended claims in accord with 37 CFR 1.121, as revised, has been provided.

No new matter has been introduced by virtue of the amendments made herein. Accordingly, applicants respectfully request their entry. In view of the amendments made herein and the remarks below, applicants respectfully request reconsideration and withdrawal of the rejection set forth in the May 5, 2003 office action.

#### **Rejection under 35 USC § 102(b)**

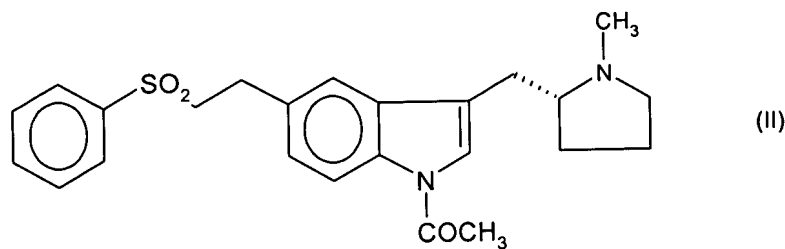
The Examiner rejected claims 19 - 23 under 35 USC § 102(b), as being anticipated by Macor et al (US 5,545,644). The Examiner cites Macor et al. as teaching eletriptan, its acid addition salt (hydrobromide) and a process of making them. The Examiner states: "The chemical compounds recited in the reference are prepared from the same precursor that is prone to forming the dimer and hence would result in the product that has an amount ( $>0$ ) of dimer in the end product as is instantly claimed." Without prejudice, and in the interests of facilitating prosecution, applicant has amended claims 19, 20 and 22 by deletion of the term "substantially" so these claims now recite "[e]letriptan which is free" of the indicated dimer. Support for this is found throughout the specification. In addition a period has been added at the end of claims 19, 20 and 22.

Applicant respectfully submits (i) that the Examiner concedes that the Eletriptan of Macor et al. contains the indicated dimer and (ii) there is no recital or suggestion in Macor et al. that the eletriptan produced therein is "free" of the dimer recited in the instant claims.

Applicant submits claims 19, 20 and 22 as amended, are patentable under 35 USC § 102(b) over the cited reference and respectfully requests withdrawal of the rejection. Applicant further submits that claim 21 which incorporates the novel features

of claim 20, and claim 23 which incorporates the novel features of claim 22 are both patentable under 35 USC § 102(b) over the cited reference and respectfully requests withdrawal of the rejection.

In order to more completely claim the invention applicant has added claims 24 - 28. Claim 24 recites that the eletriptan is "substantially free" of the aforementioned dimer and also recites that the eletriptan is "... is made by hydrolysis of a compound of formula (II)



Claim 25 which recites "pharmaceutically acceptable" salts and claim 27 which recites a "pharmaceutical composition" both recite that the eletriptan is "substantially free" of the aforementioned dimer and has been made by hydrolysis of the compound of formula II. New claim 26, dependent on claim 25 recites the hydrobromide salt and new claim 28 dependent on claim 27 also recites the hydrobromide salt. Applicant submits that there is no recital or suggestion in Macor, et al that the eletriptan produced therein is "substantially free" of the dimer recited in new claims 24, 25 and 27 "...and is made by hydrolysis of a compound of formula (II)..." as recited in claims 24, 25 and 27.

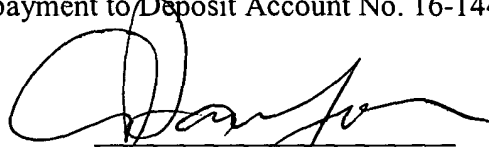
Applicant submits new claims 24, 25 and 27, are novel and unobvious and are patentable under 35 USC § 102(b) over the cited reference and respectfully requests their allowance. Applicant further submits that new claim 26 which incorporates the novel features of new claim 25, and new claim 28 which incorporates the novel features of new claim 27 are both patentable under 35 USC § 102(b) over the cited reference and respectfully requests their allowance.

In view of the amendments set forth herein and remarks above, the applicant respectfully submits that the pending claims are fully allowable, and solicits the issuance of a notice to such effect. If a telephone interview is deemed to be helpful to expedite the

prosecution of the subject application, the Examiner is invited to contact applicant's undersigned attorney at the telephone number provided.

The Commissioner is hereby authorized to charge any fees required under 37 C.F.R. §§1.16 and 1.17 or to credit any overpayment to Deposit Account No. 16-1445.

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